



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,356	04/06/2000	Brian Totty	50269-036	8053
73066      7590      06/27/2008 HICKMAN PALERMO TRUONG & BECKER LLP/Yahoo! Inc. 2055 Gateway Place Suite 550 San Jose, CA 95110-1083				
EXAMINER				
GOLD, AVIM				
ART UNIT		PAPER NUMBER		
2157				
MAIL DATE		DELIVERY MODE		
06/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/544,356

**Applicant(s)**

TOTTY ET AL.

**Examiner**

AVI GOLD

**Art Unit**

2157

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,7,9,11-26,31,33,35-50,55,57 and 59-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,9,11-26,31,33,35-50,55,57 and 59-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to the RCE amendment filed on April 11, 2008. Claims 1, 25, and 49 were amended. Claims 1, 2, 7, 9, 11-26, 31, 33, 35-50, 55, 57, and 59-72 are pending.

#### ***Response to Amendment***

##### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 25, and 49 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This limitation is not clear and is difficult to decipher: "receiving, at a porthole engine, from a browser executing on a client, an initial request for requested content".

##### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25 and 49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 25 is not limited to a tangible embodiment. In view of Applicant's disclosure, specification, page 24, lines 18-23, the medium is not limited to tangible embodiments (i.e. transmission media). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim 49 teaches a computer system. Page 24, lines 16-17 of the specification reads "embodiments of the invention are not limited to any specific combination of hardware circuitry and software." The idea that the system can be embodied fully in software makes the system, software per se and non-statutory.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 5-7, 13, 16-19, 25, 26, 31, 37, 40-43, 49, 50, 55, 61, 62, and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al., U.S. Patent No. 6,317,761, further in view of Shuster et al. U.S. Patent No. 6,687,746.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract).

As to claims 1, 25, and 49, Landsman teaches a method, computer readable medium, and a computer system, comprising the steps of:

receiving, at a porthole engine, from a browser executing on a client, an initial request for requested content (col. 25, lines 46-63; Landsman discloses a user at a client browser requesting a web page; col. 8, lines 1-40; Landsman discloses a request routed to a proxy server);

wherein said client is connected to a network through said porthole engine (col. 8, lines 1-40; Landsman discloses a client PC connected to a proxy server);

wherein said requested content resides on an origin server located separate from said porthole engine on said network (col. 8, lines 1-40; Landsman discloses a proxy server directing a request to a web server); and

said porthole engine responding to said initial request by sending to said client frame data that defines at least a first frame and at least a second frame, wherein said request content is to be displayed as an embedded item in said first frame and wherein unrequested content is to be displayed as an embedded item in said second frame (col. 1, lines 26-35; Landsman discloses advertisements transparently downloaded to a client computer and then displayed by a browser; col. 31, lines 65-67; col. 32, lines 1-49, Landsman discloses a browser displaying advertisements in frames);

causing the client to decode the sent frame data, including decoding tags for embedded items, said embedded items including the requested content and unrequested content (col. 9, lines 64-67; Landsman discloses an embedded tag that is decoded for embedded items);

causing the client to display said requested content and said unrequested content as embedded items on a single display screen of said client (col. 1, lines 26-35);

Landsman fails to teach the limitation further including causing the client to send to the porthole engine a second request for the requested content as an embedded item and the unrequested content as an embedded item.

However, Shuster teaches a system apparatus and method for hosting and assigning domain names on a wide area network (see abstract). Shuster teaches a client requesting content again after receiving the frameset data (col. 9, lines 8-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman in view of Shuster to cause the client to send to the porthole engine a second request for the requested content as an embedded item and the unrequested content as an embedded item. One would be motivated to do so because it loads the frameset with data.

Regarding claims 2, 26, and 50, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the request content includes a web page, and wherein the porthole engine causes the web

Art Unit: 2157

page to be encapsulated within a paneled frame (col. 31, lines 65-67; col. 32, lines 1-49; Landsman discloses a browser displaying content in frames).

Regarding claims 7, 31, and 55, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein:

said requested content appears on a first portion of a content display region of said browser (col. 9, lines 53-63; col. 10, lines 61-65; Landsman discloses a requested web page displayed to a user); and

said unrequested content appears on a second portion of said content display region of said browser (Landsman, col. 9, lines 53-63; col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 13, 37, and 61, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 35, and 49 wherein:

said porthole engine determines that said initial request is not a request for an embedded item by using information contained in the URL associated with said initial request and with said second request (col. 20; lines 58-67; col. 21, lines 1-10; Landsman discloses an agent checking the URL of a request); and

the step of sending frame data is performed in response to determining that said initial request is not a request for an embedded item (Landsman, col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 16, 40, and 62, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein:

said porthole engine determines that said initial request is not a request for an embedded item by using information contained in the URL associated with said initial request and with said second request (Landsman, col. 20; lines 58-67; col. 21, lines 1-10); and

said porthole engine sends data that causes said unrequested content to appear on a portion of said content display region of said browser in response to determining that said initial request is not a request for an embedded item (Landsman, col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 17, 41, and 65, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49 further comprising the step of using information about a particular user to tailor the unrequested content to that particular user (Landsman, col. 21, lines 10-28).

Regarding claims 18, 42, and 66, Landsman and Shuster teach the method, computer readable medium, and a computer system of claim 17, 41, and 65 wherein the information about the particular user is selected from a group consisting of information available to owners of the porthole engine;

information about the requested content; and



a combination of the information available to the owners of the porthole engine and the information about the requested content (Landsman, col. 21, lines 10-28).

Regarding claims 19, 43, and 67, Landsman and Shuster teach the method, computer readable medium, and a computer system of claim 1, 25, and 49 further comprising the step of identifying the users to personalize the unrequested content (col. 21, lines 10-28; Landsman discloses advertisements specifically targeted to the user).

6. Claims 9, 11, 12, 33, 35, 36, 57, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Shuster further in view of Eilbott et al., U.S. Patent No. 6,553,393

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Shuster teaches the invention substantially as claimed including a system apparatus and method for hosting and assigning domain names on a wide area network (see abstract).

As to claims 9, 33, and 57, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein said porthole engine determines the format in which to display said requested content and said unrequested content based on one or more factors including at least one of differences

in browsers, components of requested web pages, and versions of the browsers (col. 21, lines 10-28; Landsman discloses ad selection based on user specific info collected from and associated with the user operating the browser).

Landsman and Shuster fail to teach the limitation further including the content format chosen by the porthole engine.

However, Eilbott teaches managing references to embedded objects in a markup language data stream (see abstract). Eilbott teaches the use of a proxy server to choose and translate the format of a page (col. 5, lines 12-23).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Shuster in view of Eilbott to use a porthole engine to choose a content format. One would be motivated to do so because it avoids the transfer of data to other servers, which would speed up the generation of data and be more efficient.

As to claims 11, 35, and 59, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49 further comprising the steps of:

the porthole engine receiving a series of subsequent requests from the browser in response to the browser decoding said frame data, said series of subsequent requests including the second request for said requested content (col. 8, lines 41-67; Landsman discloses downloading restarted after another request); and

the porthole engine responding to said second request for said requested content by requesting said requested content from said origin server and delivering said requested content to said browser (col. 19, lines 25-63; Landsman discloses an agent server downloading contents from another server).

Landsman and Shuster fail to teach the limitation further including requests received from a browser processed by a proxy server.

However, Eilbott teaches the use of the proxy server requesting a page from the origin server and delivering it to the requesting browser (col. 4, lines 22-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Shuster in view of Eilbott to use a proxy server to process requests received from a browser. One would be motivated to do so because it avoids the transfer of data to other servers, which would speed up the generation of data and be more efficient.

Regarding claims 12, 36, and 60, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 11, 35, and 59 wherein said porthole engine determines that said second request for said requested content is not an initial request for said requested content by using information contained in the URL associated with said initial request and with said second request (col. 7, lines 66-67; col. 8, lines 1-40; Landsman discloses the proxy server providing files from cache to other client PCs if they request the same files).

7. Claims 14, 15, 38, 39, 63, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Shuster further in view of Ackermann, Jr. et al., U.S. Patent No. 6,606,653.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Shuster teaches the invention substantially as claimed including a system apparatus and method for hosting and assigning domain names on a wide area network (see abstract).

As to claims 14, 15, 38, 39, 63, and 64, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49.

Landsman and Shuster fail to teach the limitation further including the changing a target attribute of a link in an embedded frame document to affect frame behavior.

However, Ackermann teaches the updating of embedded links or hotspots in source Web pages to reflect the new URLs of moved target Web Pages (see abstract). Ackermann teaches the use of a URL of a link being changed to point to a new URL (col. 5, lines 25-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Shuster in view of Ackermann to change a target attribute of a link. One would be motivated to do so because it would allow for the proper URL of the link to be shown.

8. Claims 20, 44, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Shuster further in view of Underwood, U.S. Patent No. 6,704,873.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Shuster teaches the invention substantially as claimed including a system apparatus and method for hosting and assigning domain names on a wide area network (see abstract).

As to claims 20, 44, and 68, Landsman and Shuster teach the method of claims 19, 43, and 67.

Landsman and Shuster fail to teach the limitation further including the method of Claim 19 wherein the step of identifying the users is performed by a method selected in a group consisting of:

- attaching cookies to web pages that are browsed by a particular user;
- observing the radius authentication transactions and the resulting network address assigned to the client;
- tracking network addresses assigned to the users; and
- authenticating the user.

However, Underwood teaches secure gateway interconnection in an e-commerce based environment (see abstract). Underwood teaches the use of cookie authentication (col. 140, lines 29-46; col. 141, lines 30-45), a RADIUS server performing authentication and allowing traffic from the client (col. 287, lines 65-67; col. 288, lines 1-

28), tracking of an IP address (col. 10, lines 3-18), and authenticating the identity of a user (col. 50, lines 34-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Shuster in view of Underwood to attach cookies to web pages that are browsed by a particular user, observing the radius authentication transactions and the resulting network address assigned to the client, tracking network addresses assigned to the users, and authenticating the user. One would be motivated to do so because they are all efficient methods of identifying a user and personalizing unrequested content for them.

9. Claims 21-23, 45-47, and 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Shuster further in view of Markus, U.S. Patent No. 6,499,042.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Shuster teaches the invention substantially as claimed including a system apparatus and method for hosting and assigning domain names on a wide area network (see abstract).

As to claims 21-23, 45-47, and 69-71, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49.

Landsman and Shuster fail to teach the limitation further including the automatically filling in one or more fields on a requested web page by using a database coupled to the porthole engine.

However, Markus teaches an improved process that allows an entity to automatically release personal data to other entities connected via a computer network (see abstract). Markus teaches the use of a selective proxy server for automatically filling in an online form and a personal data storage component used to for the information to fill the forms in with (col. 1, lines 40-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Shuster in view of Markus to automatically fill in one or more fields on a requested web page by using a database coupled to the porthole engine. One would be motivated to do so because it would allow the user to fill in forms without entering anything.

10. Claims 24, 48, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Shuster further in view of Shapiro et al., U.S. Patent No. 5,991,810.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Shuster teaches the invention substantially as claimed including a system apparatus and method for hosting and assigning domain names on a wide area network (see abstract).

As to claims 24, 48, and 72, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49.

Landsman and Shuster fail to teach the limitation further including the use of a content filtering technology based on identities of the users.

However, Shapiro teaches user name authentication for gateway clients accessing a proxy cache server (see abstract). Shapiro teaches the use of automatically restricting access by unauthorized users to specified web information (col. 1, lines 56-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Shuster in view of Shapiro to use a filter to allow only authorized users access to particular web pages. One would be motivated to do so because it would allow a way to make certain web pages exclusive.

### ***Response to Arguments***

11. Applicant's arguments filed April 11, 2008 have been fully considered but they are not persuasive.

12. In response to applicant's arguments, for claims 1, 25, and 49, against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The applicant is not viewing the combination of



Landsman and Shuster. Landsman discloses requesting embedded items, of requested and unrequested content, from a porthole engine. Shuster is used to show a second request for content.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,854,897 to Radziewicz et al.

U.S. Pat. No. 6,128,655 to Fields et al.

U.S. Pat. No. 6,338,059 to Fields et al.

U.S. Pat. No. 6,466,975 to Sterling.

U.S. Pat. No. 6,128,651 to Cezar.

U.S. Pat. No. 6,636,247 to Hamzy et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AVI GOLD whose telephone number is (571)272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2157

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

AMG

/Ario Etienne/  
Supervisory Patent Examiner, Art Unit 2157